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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,182	03/25/2004	Kuniharu Umeno	033036.076	6820

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SMITH, GAMBRELL & RUSSELL
SUITE 3100, PROMENADE II
1230 PEACHTREE STREET, N.E.
ATLANTA, GA 30307-3592

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,182

Applicant(s)

UMENO ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. It is unclear how Tables 1 and 2 on pages 21 and 22 of the specification have been amended as presented on pages 6 and 7 of the amendment filed October 30, 2006 since the nature of the modification is not discussed in the Remarks/Arguments section.
2. The denotation of R_2 of the phenol resin (B) of general formula (2) as including hydrogen is substantiated by the first and third pages the MSDS data sheets which depict the chemical structures for the MEH 7851SS and XLC-LL phenol resins exemplified on page 17, lines 3-5 and page 19, lines 5-7 of the specification. However, the limitation should also be inserted into page 3, lines 11-12 of the specification for proper support.
3. The adoption of the suggested language for clarifying the position of the hydroxyl groups in Compound (F) in claims 1 and 6 resolves the 35 U.S.C. 112, second paragraph rejection advanced in the non-Final rejection mailed June 28, 2006. However, the specification on page 3, lines 14-16 and page 13, lines 4-5 should also be amended to more clearly denote Compound (F) and to be consistent with the claim terminology.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed June 28, 2006.

Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of Umeno et al. Patent No. 7,023,098.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by

Umeno et al.

4. Gallo Patent No. 6,432,540 and Iwasaki et al. Patent No. 6,242,110 previously relied upon to teach the obviousness of employing a phenol aralkyl resin wherein phenolic group R_2 is limited to C_1 - C_4 alkyls is no longer necessary since the scope of R_2 has been broadened to include hydrogen. Umeno et al. (col. 8, lines 55-57 and col. 10, lines 20-22 exemplify the same MEH 7851SS and XLC-LL phenol aralkyl resins as utilized in the examples of the instant specification.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 2003-292730 in view of Japanese Patent No. 3-29352.

Gallo and Iwasaki et al. have been removed for the same reasons as espoused with respect to Umeno et al. in previous paragraph 4. Japanese '730 (translation, page 4, paragraph 14) shows the same XLC-LL as exhibited in the specification.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallo and Iwasaki et al. in view of Japanese '352.

5. According to MPEP § 2144, "Rationale Different from Applicant's is Permissible," "[t]he reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." *In re Linter*, 173 USPQ 560, CCPA 1972; *In re Dillon*, 16 USPQ 2d 1897, Federal Circuit 1990.

6. Therefore, it would have been obvious to one of ordinary skill in the art to employ the disclosed catechol or pyrogallol of Japanese '730, or to incorporate the ortho-phenolic compound of Japanese '352 into the formulations of Gallo and Iwasaki et al. in order to enhance the moisture resistance leading to higher reliability (Japanese '352, Derwent abstract, Use/Advantage section).

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The amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712